RACHEL KREVANS (CA SBN 116421)
MATTHEW I. KREEGER (CA SBN 153793)
JASON A. CROTTY (CA SBN 196036)
DAVID M. HYMAS (CA SBN 226202)
MORRISON & FOERSTER LLP
425 Market Street
San Francisco, California 94105-2482
Telephone: 415.268.7000
Facsimile: 415.268.7522
RKrevans@mofo.com
MKreeger@mofo.com
JCrotty@mofo.com
DHymas@mofo.com

Attorneys for Defendants
ECHOSTAR SATELLITE LLC AND
ECHOSTAR TECHNOLOGIES CORP.

VICTOR G. SAVIKAS (CA SBN 145658)
LOUIS TOUTON (CA SBN 102380)
KEVIN G. McBRIDE (CA SBN 195866)
JONES DAY
555 South Flower Street, Fiftieth Floor
Los Angeles, California 90071
Telephone: 1.213.489.3939
Facsimile: 1.213.243.2539
vgsavikas@jonesday.com
lltouton@jonesday.com
kgmcbride@jonesday.com

Attorneys for Defendant
THE DIRECTV GROUP, INC.

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. 05-CV-1114 JW MDL No. 1665 **REPLY IN SUPPORT OF THE SATELLITE DEFENDANTS' MOTION FOR SUMMARY JUDGMENT OF INVALIDITY OF THE '992, '863, AND '720 PATENTS** Date: TBD Time: TBD Courtroom: 8, 4th Floor Judge: Hon. James Ware

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I. INTRODUCTION

As the Satellite Defendants' motion detailed, the Yurt patents are nothing more than a starting point for future research and development. Rather than describing the invention so that a skilled artisan could recognize or use what was claimed, the specification and claims often point to vague, undefined components of the patentees' purported transmission and reception system, which can supposedly operate on a myriad of different, often-incompatible, technologies and platforms. The actual description of those components and related methods is missing entirely or limited to what the patentees hoped their invention could accomplish. Such disclosure fails the written description and enablement requirements and does not entitle the patentees to the patent system's protections. *See Brenner v. Manson*, 383 U.S. 519, 536 (1966) ("[A patent] is not a reward for the search, but compensation for its successful conclusion.").

Acacia's opposition underscores why the Satellite Defendants' motion should be granted. Acacia ignores the Court's claim construction, its own statements and those of its expert, and even a stipulation that it filed with this Court. Because they cannot point to the necessary disclosure, Acacia and its expert repeatedly attempt to rely on what Acacia evidently wishes the patentees had included in the specification, claiming that adequate description is "inherently" found in the specification and the knowledge of those skilled in the art.

Acacia's efforts to manufacture disclosure that does not exist cannot create a triable issue of fact or save the inadequately-supported claims from summary judgment. Because the facts necessary to resolving the Satellite Defendants' motion are beyond genuine dispute, the motion should be granted and the asserted claims declared invalid.[1]

II. THE ASSERTED METHOD CLAIMS THAT DO NOT INCLUDE A USER REQUEST FAIL THE WRITTEN DESCRIPTION REQUIREMENT.

Acacia does not dispute the specification's numerous statements regarding user-selected transmissions, its expert's opinion that the patent is fundamentally about video-on-demand, the specification's distinguishing of *every* prior art reference based on a purported lack of user

[1] The Satellite Defendants also join the Round 3 Defendants' Reply brief. The Satellite Defendants write separately to address issues specific to the Satellite Defendants' motion.

requests, and the Court's conclusion that "every part of the specification" describes sending information in response to user requests. As the Satellite Defendants have shown, the asserted method claims are thus invalid because they claim more broadly than the specification describes.

Acacia contends that a single original claim somehow provides the required written description support for these claims. Acacia's argument was expressly rejected by the Federal Circuit in *LizardTech*. There, the patent described a method for creating a seamless discrete wavelet transform (DWT) to compress digital images. *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1337 (Fed. Cir. 2005). The specification disclosed only one method for creating a seamless DWT, which required "maintaining updated sums of DWT coefficients." *Id*. at 1344. Claim 21 of the issued patent, however, lacked the "maintaining updated sums" limitation and was thus broader than the disclosure. *Id*.

In holding the claim invalid, *the Federal Circuit rejected the identical argument that Acacia makes here*. Like Acacia, LizardTech argued that because an original claim lacked the "maintaining updated sums" limitation, the inventors were in possession of different methods of performing DWT-based compression to create a seamless DWT. The Federal Circuit disagreed:

> While it is true that an originally filed claim can provide the requisite written description to satisfy section 112, *see Union Oil Co.*, 208 F.3d at 998 n. 4, nothing in claim 21 or the specification constitutes an adequate and enabling description of all seamless DWTs.

Id. at 1346.[2] As the Federal Circuit held in *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 968-69 (Fed. Cir. 2002), "[i]f a purported description of an invention does not meet the requirements of the statute, the fact that it appears as an original claim or in the specification does not save it. A claim does not become more descriptive by its repetition, or its longevity." If the words of the claim are not in and of themselves sufficient to describe the subject matter, whether they were in an original claim or not, the specification must still provide sufficient written description in order to support the later-issued patent claim.

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[2] Acacia's opposition relies on the same *Union Oil* footnote that the *LizardTech* court found unpersuasive. (Opp'n at 96 (citing *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 208 F.3d 989, 998 n.4 (Fed. Cir. 2000)).)

As in *LizardTech*, neither the specification nor original Claim 1 provides an adequate description of a method of transmitting data without a user request. For example, original Claim 1 requires that "at least a portion of one of the files" is transmitted. Like the method claims without user requests, however, it fails to explain how a portion of an item, or any item, could be defined or selected or possibly be sent without a user request, when such a transmission would occur, or what portion of the item would be transmitted. As this Court found:

> Every part of the specification *clearly states an intent* by the inventors that the "transmission system" and the "receiving system" process, store, send and receive the information *specifically in response to "users."*

(Ex. I, *Markman VI* at 4 n.5 (emphasis added).)[3] Acacia cannot rely on an original claim that also fails to include an element required by the specification to save other similar, inadequately-described method claims.

Acacia also misleadingly quotes the specification in an effort to argue that the applicants included a "transmitter means," which, according to Acacia, did not provide for user requests. (Opp'n at 95-96.) But the text quoted by Acacia plainly states that the "transmitter means" can only send "a ***specific*** file to a ***specific*** one of the remote locations." (Opp'n at 98 (quoting '992 patent, 2:46-48) (emphasis added).) The *very next sentence* from the specification makes it clear that the "specific file" and "specific location" are selected by the user:

> The present invention further comprises a distribution method *responsive to requests identifying information to be sent from a transmission system to a remote location*, the method comprising the steps of storing audio and video information in a compressed data form; *requesting transmission, by a user, of at least a part of the stored compressed information to the remote location*; sending at least a portion of the stored compressed information to the remote location; receiving the sent information at the remote location; buffering the processed information at the remote location; and playing back the buffered information in real time *at a time requested by the user*.

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[3] Exhibits are attached to the Declaration of Matthew I. Kreeger (D.I. 298) unless otherwise noted.

’992 patent, 2:49-61 (emphasis added). Thus, like the other components of the transmission system, the “transmitter means” also depends on user requests to designate the item to be transmitted, the location to which the transmission is sent, and the time of the transmission.

Acacia also argues that the “transmitter means” of Claim 1 can satisfy the “objects” and “purposes” of the invention without employing user requests. (Opp’n at 95-96.) Those objects and purposes, however, expressly include: providing “a user with the capability of accessing audio/video material,” allowing “the user to remotely select audio/video material,” transmitting audio/video material “to any location chosen by the user that has a specified receiver,” allowing a user to play back material “at any time selected by the user,” and allowing a user to select audio material, video material or both. ’992 patent, 1:57-2:16. In other words, each of the patent’s purposes references user requests.

In fact, the specification language on which Acacia relies is fully consistent with the remainder of the disclosure, which demonstrates that user requests were required by the applicants’ purported invention. *See, e.g., id.* 1:8-10; 1:57-2:10; 2:25-3:15; 3:55-60; 5:10-14; 14:3-20, 24-33, 39-40, 45-48; 15:33-54; 18:47-50; 18:53-56; 19:21-24; Figs. 3, 4, 5, 7. For example, the descriptions of the distribution method *each include user requests*. *See, e.g., id.* at 2:49-61; 18:46-59; Fig. 7. Indeed, the distribution method is initiated “*upon a request by a user of the distribution system*.” *Id.* at 18:53-56 (emphasis added). Even Mr. Weiss admits that the patent is fundamentally about video-on-demand. (Open. Br. at 6 (quoting 9/8/05 Hearing Tr. at 27).) Acacia cannot now expand its limited disclosure by claiming more broadly than the specification describes.

The Federal Circuit’s recent *ICU Medical* decision confirms that claims cannot be broader than the disclosure. *ICU Med., Inc. v. Alaris Med. Sys., Inc.*, No. 2008-1077, 2009 U.S. App. LEXIS 5271 (Fed. Cir. Mar. 13, 2009). In that case the court held that the “spikeless” claims at issue “refer to medical valves generically—covering those valves that operate with a spike and those that operate without a spike. *But the specification describes only medical valves with spikes*.” *Id.* at *17 (emphasis added). The court therefore invalidated the asserted spikeless claims because they were broader than the disclosure and a skilled artisan "would not understand the inventor of the '509 and '592 patents to have invented a spikeless medical valve." *Id.*

Finally, Acacia ignores the fact that the specification itself discusses and attempts to distinguish numerous prior art references on their supposed lack of user requests. '992 patent, 1:20-56. This confirms that user requests were key to the patent's disclosure and that the specification does not support broader claims. *See Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998) ("Instead of suggesting that the '589 patent encompasses additional shapes, the specification specifically distinguishes the prior art as inferior and touts the advantages of the conical shape of the '589 cup. Such statements make clear that the '589 patent discloses only conical shaped cups and nothing broader.") (citation omitted).

In sum, Claims 41 of the '992 patent, 17 of the '863 patent, and 11 of the '720 patent — none of which includes user requests — do not meet the written description requirement. Dependent Claim 45 of the '992 patent and Claims 18-19 of the '863 patent fail the written description requirement for the same reasons.

III. THE SPECIFICATION DOES NOT DESCRIBE OR ENABLE A "TRANSMISSION SYSTEM" RETAINING PHYSICAL ITEMS.

Acacia does not dispute the Court's conclusion regarding Claim 41's initial step that "*[t]he specification is silent* as to what component of the 'transmission system' is capable of performing the 'retaining' step." (Ex. H, *Markman V* at 17 n.17 (emphasis added).) Acacia also does not dispute that its expert, Mr. Weiss, defines the storing requirement to "[require] active maintenance in order to avoid deterioration of the material." (Ex. L, Weiss Decl. ISO Mot. for Reconsideration at 6.) And Acacia does not point to any part of the specification that describes any such "active maintenance," including any of the examples recited by Mr. Weiss.

Instead, Acacia supposedly finds written description for the "storing" step in a single sentence in the specification that refers to the transmission system "preferably includ[ing] source material library means for temporary storage of items . . . ." (Opp'n at 111.) The specification, however, provides no disclosure regarding what the "means for temporary storage" is or what is involved in actively retaining the physical items in the source material library. *Cf. Univ. of*

Rochester v. G.D. Searle & Co., 358 F.3d 916, 929 (Fed. Cir. 2004) (patent invalid for lack of adequate written description where specification failed to steer skilled practitioner to compounds that could be used in claimed method). The only structure mentioned in the specification that is even remotely associated with a "source material library means" is the "source material library" itself. *See, e.g.,* '992 patent, 6:10-15, 23-26. The specification is silent, however, as to what part of the "source material library" performs the retaining function or what the source material library is. Indeed, as the Court has already found, the specification includes *no* disclosure regarding which component can perform the "retaining" function. (Ex. H, *Markman V* at 17 n.17.)

Moreover, Acacia's reliance on the specification's description of "temporary storage" contradicts Mr. Weiss's own opinion of what the "storing" step requires. According to Mr. Weiss, the "active maintenance" described by the storing step requires, among other things, "the periodic movement of copies of the content from one medium to another as the medium on which the content is stored reaches end-of-life as an individual unit or when the particular type of medium is no longer supported as a product and is superseded by more modern technology." (Ex. L, Weiss Decl. at 6.) Plainly, such maintenance is not temporary in nature. Hence, the temporary storage reference does not support Mr. Weiss's view of the storing step.

Acacia contends that the specification need not describe "how" retaining is achieved because "how" is supposedly not a limitation of the asserted claims. (Opp'n at 111.) Mr. Weiss opines, however, that a skilled artisan would read the retaining step to *require* "active maintenance" of the items. At best, the specification provides a "vague functional description" of the step, which would not lead someone of ordinary skill in the art to conclude that the patentees possessed a transmission system invention that actively "retained" physical items in a library. *See LizardTech*, 424 F.3d at 1345. Claim 41's storing step fails the written description requirement.

IV. THE SPECIFICATION DOES NOT DESCRIBE OR ENABLE GETTING INFORMATION BACK FROM THE PHYSICAL ITEMS.

Acacia argues that the written description for Claim 41's "retrieving" step is found in the specification's use of an "identification encoding means." (Opp'n at 112.) But the Court has already determined that the "identification encoding means" lacks corresponding structure, (Ex.

D, *Markman I* at 21), and that one of ordinary skill "would not understand the scope or bounds of the structure of the term 'identification encoder' when that term is read in light of the specification." (Open. Br. at 14.) The Court's conclusion is plainly correct since neither the terms nor the specification impart any understanding as to what an identification encoder is and, therefore, cannot show what the inventors thought of as their invention. *See, e.g., Univ. of Rochester*, 358 F.3d at 928 (vague functional description does not satisfy the requirement that the "specification set forth enough detail to allow a person of ordinary skill in the art to understand what is claimed and to recognize that the inventor invented what is claimed"). That the words "identification encoding means" appear in originally filed Claim 1 does not make it any more definite or supportive of the claimed invention. *See, e.g., LizardTech*, 424 F.3d at 1346-37 (finding a claim identical to originally filed claim does not automatically satisfy written description requirement where "nothing in [the claim] or the specification constitutes an adequate and enabling description").

Acacia also points to a single sentence from the specification in an attempt to find written description support: "the first step of the distribution method 400 involves retrieving the information for selected items in the source material library . . . ." (Opp'n at 112 (quoting '992 patent, 18:53-56).) Acacia ignores the fact that the *transmission system* must perform the steps of Claim 41, as the Court has already found. (Ex. F, *Markman III* at 29.) The sentence upon which Acacia relies does not describe any component of the "transmission system" performing the claim step or the manner in which the "retrieving" is performed. Stating that retrieving is somehow performed is *not* the same as describing the actual manner of retrieval or disclosing a component that can be used to retrieve the information from the physical items stored in the source material library. The mere concept of retrieval, without more, is insufficient to satisfy the written description requirement. *See Univ. of Rochester*, 358 F.3d at 928.

As to enablement, Acacia argues that it is met by the specification's discussion of a digital telecine device and an audio playback device. But the portion of the specification cited by Acacia indicates that the information in the film is retrieved *before* the frames are passed through a telecine device and *before* the audio is passed through an audio playback device:

> If, for example, the *retrieved information* to be converted from the source material library 111 is a motion picture film, the picture frames in the film are passed through a digital telecine device …. Accompanying audio information is passed through an optical or magnetic digital playback device.

(Opp'n at 112 (citing '992 patent, 7:35-43) (emphasis added).) This passage thus only discusses what might happen to the information *after* it is retrieved. It fails to describe the act of retrieving the information from the physical items nor does it identify what part of the transmission system performs that act. Thus, it cannot serve as enabling disclosure for the "retrieving" step.

Moreover, the telecine and audio playback devices are limited to manipulating information from motion picture films. In contrast, the retrieving step broadly claims retrieving *any* digital video or audio data on a variety of physical items. The specification does not explain what retrieves data from other physical items, such as video tapes, laser disks, optical disks, magnetic disks, computer tapes, disks, and cartridges, in the source material library. Acacia does not contend otherwise. Instead, Acacia relies on the conclusory opinions of Mr. Weiss, who states: (1) that skilled artisans knew how to manually retrieve such physical items, (Weiss Decl. ¶¶ 59-60), and (2) that "[*i*]*n many cases*, by the start of 1991, it would have been possible to *automate* the processes of retrieving items from storage and playing them back on appropriate machines, scanning them on appropriate scanners, and the like" (*Id*. ¶ 61 (emphasis added)).

Mr. Weiss's opinion highlights the specification's lack of enabling disclosure. The patentee must enable the "full scope" of the claimed invention — not what a skilled artisan would be able to create "in many cases." *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993). The specification does not teach how its transmission system would "get back" the information contained on the numerous different types of physical items in the source material library, as the Court's construction requires. Mr. Weiss's declaration only confirms that the full scope of the claim step was not disclosed in the specification or known by those of skill in the art.

Finally, the identification encoder, which is the only component disclosed in the patent arguably linked to retrieving information from the physical items, itself is not enabled. The specification does not describe how the device accomplishes the retrieval function (or the numerous other functions that the specification ascribes to it). Such limited disclosure is not enabling. *See Automotive Techs. Int'l, Inc. v. BMW of N. Am., Inc.*, 501 F.3d 1274, 1283 (Fed. Cir. 2007) ("conceptional view" of electronic sensor failed to show one skilled in the art how to make or use the sensor and was therefore not enabling). As the Satellite Defendants' motion detailed, (Open. Br. at 15), even Mr. Weiss conceded that the "identification encoder" was not an off-the-shelf component available for purchase and that therefore it would have to be specially engineered to meet the particular design requirements of different systems. (Ex. B, 9/9/2005 Tr. at 246-47.) Where the specification fails to disclose structure for any of the technologies mentioned, a "mere boxed figure [of the device] and the few lines of description fail to apprise one of ordinary skill how to make and use [the device]." *Automotive Techs.*, 501 F.3d at 1283. Similarly, Acacia's vague black-box description of the identification encoder fails the enablement requirement.

V. THE SPECIFICATION DOES NOT DESCRIBE OR ENABLE "INPUTTING AN ITEM . . . INTO THE TRANSMISSION SYSTEM."

As Acacia has previously conceded, the specification includes *no* disclosure regarding inputting items into the transmission system. As a result, neither the written description nor the enablement requirements have been met for independent Claim 17 and dependent Claims 18-19.

Acacia first tries to find support for the "inputting" step by arguing that something other than the transmission system could perform this step. Acacia ignores the fact that the parties have already stipulated that the claims *require* the transmission system to perform the step:

> In Claim 17 of the '863 patent, the "formatting step" includes . . . (a) "inputting an item having information into the transmission system"; . . . the parties agree that . . . *the formatting steps, including steps (a) - (d) listed above, are performed by the transmission system*.

(Ex. J, 7/21/2006 Stip. at 3 (emphasis added), filed at D.I. 187.) Acacia argues that the Court did not address the transmission system performing Claim 17's formatting steps. (Opp'n at 104 n.40.) The Court's constructions of other terms in Claim 17, however, are completely consistent with Acacia's stipulation that the transmission system performs the claim's formatting steps. Acacia cannot defeat summary judgment by ignoring the claim construction to which it formally stipulated almost three years ago. *See JSR Corp. v. Tokyo Ohka Kogyo Co.*, No. C 99-20156 JW, 2001 U.S. Dist. LEXIS 24959, at *16-19 (N.D. Cal. Sept. 12, 2001) (denying plaintiff permission to change "stipulated construction" and invalidating claims based on stipulation where parties and Court relied on it by abandoning "a timely claim construction hearing, and [the defendant] prepared and filed its summary judgment motion" since to allow amendment "would encourage the 'vexatious shuffling of positions' that the patent local rules were designed to avoid").

In any case, Claim 17 fails the written description requirement — whether the "inputting" is performed by the transmission system or some mysterious, undisclosed component — since there is no disclosure of *anything* "putting physical items . . . into the transmission system." As the Satellite Defendants' motion demonstrated, Acacia's counsel told this Court that the specification does not describe "how information gets placed into a source material library" since "all that is being disclosed isn't that, as how things are being stored or put in. It's just that they're there." (Open. Br. at 17 (quoting 8/17/2007 Tr. at 202-03).) Even Acacia's opposition concedes that the specification "does not use the specific words or present drawings which explicitly state or depict that an item of information is input into the 'transmission system.'" (Opp'n at 105; *see also* Ex. H, *Markman V* at 16; Ex. G, *Markman IV* at 23; Ex. F, *Markman III* at 30.)

Acacia's opposition ignores these admissions, and instead argues, based on an expert declaration, that the specification "inherently" describes the inputting step. (Opp'n at 106.) According to Acacia, because the specification shows items in the source material library, they must necessarily have first been input into the transmission system. (*Id.*) But Acacia's argument sidesteps the issue — there is no disclosure, inherent or otherwise, of the transmission system or anything else "inputting" items as the claim language (and the Court's construction) requires.

To be inherent "the missing descriptive matter must necessarily be present in the parent application's specification such that one skilled in the art would recognize such a disclosure." *Tronzo*, 156 F.3d at 1159. Disclosure that would be obvious to one skilled in the art is not enough — "[i]t is not sufficient for purposes of the written description requirement of § 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose." *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997); *see also Regents of the Univ. of Cal. v. Eli*

Lilly & Co., 119 F.3d 1559, 1566-67 (Fed. Cir. 1997) (explaining that "an applicant complies with the written description requirement by describing the invention, with all its claimed limitations, not that which makes it obvious") (internal quotation marks omitted). The issue is *not* "whether one skilled in the art might be able to construct the patentee's device from the teachings of the disclosure of the application. Rather, it is a question whether the application necessarily discloses that particular device." *Univ. of Rochester*, 358 F.3d at 923. Where there is *no* disclosure, Acacia cannot manufacture missing pieces with the opinion of its retained expert.

The Federal Circuit's decision in *TurboCare Division of Demag Delaval Turbomachinery Corp. v. GE, Co.*, 264 F.3d 1111 (Fed. Cir. 2001), refutes Acacia's argument. In *Turbocare*, the patent covered seals used in fluid-driven devices such as steam turbines. *Id*. at 1113. The defendant raised written description challenges as to the type and location of springs used in the seals. *Id*. at 1118. As to the location, the specification said only that the springs were "located . . . adjacent to" ring segments. *Id*. at 1119. The patentee argued that the only viable location for the springs "would be between the casing shoulders and the shoulders of the outer ring portion of the segment" and that the subject matter was therefore inherently disclosed. *Id*. The Federal Circuit rejected the patentee's argument and the "conclusory statements" of its expert witness:

> [The inventor's] original disclosure is *completely lacking* in any description of an embodiment in which the spring is located between the casing shoulders and the inner surface of the outer ring portion of the ring segment. Such an embodiment may have been obvious from [the inventor's] vague reference to a "spring located . . . adjacent to said rings." As we held in *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565 (Fed. Cir. 1997), however, that is not enough to satisfy the written description requirement.

Id. (emphasis added). The court thus affirmed the district court's holding that the spring's location was not inherently disclosed and that a skilled artisan would not have recognized that the patentees invented what was claimed. *Id*; *see also PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306-10 (Fed. Cir. 2008) (rejecting "conclusory expert declaration" and argument that "customer interface" could inherently be part of customer's laptop, rather than vending machine, where there was "simply no disclosure in the Original Application of a user interface that is either located on a customer's laptop or even separate from the vending machine itself").

Here, like *TurboCare* and *PowerOasis*, there is no disclosure of the transmission system or anything else "inputting" physical items into a source material library. The applicants failed to disclose the step itself, what is performing the step, or how anything could possibly accomplish the "inputting" function. That items may eventually arrive in the source material library does not address what put them there or how the applicants' supposed invention performed that action.

Accordingly, Claim 17 and dependent Claims 18-19 fail the written description requirement. *Univ. of Rochester*, 358 F.3d at 922-23. Because the specification fails to disclose *anything* regarding how one of skill in the art would make or use the invention, the claims are also not enabled. *Automotive Techs.*, 501 F.3d at 1285; *LizardTech*, 424 F.3d at 1344-46.

VI. CLAIM 11 OF THE '720 PATENT FAILS TO DESCRIBE OR ENABLE SUBSCRIBERS TO DESIGNATE INDIVIDUAL RECEIVING DEVICES.

Acacia argues that the specification describes and enables the "subscriber selectable receiving stations" of Claim 11 of the '720 patent because it mentions users selecting the locations where transmissions are received and because its expert opines that "conditional access" technology was known in the art. (Opp'n at 116-18.) Acacia misses the point. Selecting a "location" is *not* the equivalent of selecting a receiving station, and Acacia cannot rely on the knowledge of its experts or one of skill in the art to overcome the specification's failings.

According to Acacia's own prosecution history statements, the novel aspect of Claim 11 was the purported selectability of the receiving stations. The *only* distinction asserted by the applicants between Acacia's application and the Hoarty reference was that Hoarty "does not allow the user to select another premises or a subscriber *selectable* receiving station to which information is transmitted." (Ex. P, 6/7/1999 Reply and Amendment at 8 (emphasis in original).) In other words, the applicant asserted that Claim 11 was novel because it allowed the user to choose a remote location, *as well as* to "designate" a particular receiving station.

Under well-established Federal Circuit law, Claim 11 is thus not described or enabled:

> "It is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement." Although the knowledge of one skilled in the art is indeed relevant, *the novel aspect of an invention must be enabled in the patent*. . . . Given that the novel aspect of the

> invention is side impact sensors, it is insufficient to merely state that known technologies can be used to create an electronic sensor.

Automotive Techs., 501 F.3d at 1283 (quoting *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997) (emphasis added)). The novel aspects of an invention require an enabling disclosure *regardless* of the knowledge in the art.

Acacia's opposition ignores these prosecution statements confirming that the supposedly novel feature of Claim 11 was the ability of a user to select a receiving device. Instead, Acacia conflates the user's ability to select from among different locations *and* from among different devices. Acacia points to several areas of the specification that it claims describe the user's ability to designate receiving devices. But *each* of these citations points to a user's ability to select the location that receives transmissions — *not* the user selecting a particular device. (Opp'n at 117.) For example, the citations refer to the ability of the user to select the "destination," "premises," "location of playback," or "address of the user." None of these references mentions the ability of a user to select from among various "receiving stations." Nor do the cited portions of the specification refer to the ability of a subscriber to designate a "receiving device or devices." In fact, they do not mention "receiving devices" at all.[4]

When the Yurt patentees wanted to claim sending transmissions to a specific "location" or "premises," they knew how to do so. *See, e.g.*, '992 patent, Claims 1 (transmission to "one of the remote locations"), 41 (same), 19 (transmission to "selected remote location"), 47 (same); '275 patent, Claims 1 (transmission to "one of the remote locations"), 2 (same), 4 (same), 5 (same), 7 (same); '863 patent, Claims 1 ("one of the remote locations"), 10 ("one of a plurality of the remote locations"). The '720 patent itself claims a transmission system that sends data to "the *premises selected by the user*" without referring to "receiving stations." '720 patent, Claim 1 (emphasis added). In contrast, Claim 11 claims transmissions to "selectable receiving stations" at a "*premise* geographically separated from the *location* of the local distribution system." Simply put, selecting a "location," "premises," "user address," or "destination" is *not* the same as designating a "receiving device" from among multiple such devices, as the claim language and the Court's construction require.

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[4] Acacia points to a passage in the specification that refers to transmitting data faster than real time "to any location chosen by the user that has a specified receiver." (Opp'n at 117 (citing '992 patent, 1:67-2:4).) But what that "specified receiver" is, how subscribers can designate it from among different receivers, or whether it is even the equivalent of a receiving device, the specification never says.

Even Acacia's expert, Mr. Weiss, concedes that the specification does not describe the claim term. Mr. Weiss states that in the claimed system, "the Reception Systems must be addressable in such a way that they only will receive content that is addressed to them." (Weiss Decl. ¶ 165.) Such addressability could be "obtained through a method known as 'conditional access,'" which by 1991 was "well and widely known." (*Id.* ¶ 166.)

But the specification says *nothing* about "conditional access." Indeed, Mr. Weiss concedes that such addressability is not described in the specification. Instead, he states:

> For the redistribution method to function, there needs to be a transfer of information from the Transmission System to a subscriber management system associated with the conditional access system on the output of the Reception System, so that the subscriber management system can direct specific content from the Reception System to a specific subscriber. *The need for such information transfers is inherent in the configuration of the systems presented in Figures 1d, 1e, and 1f, and the text describing them in the specification of the '992 patent.* The information transfer process *would be part of the software processes necessary* to operate the overall transmission and reception system and would have been apparent to one of ordinary skill in the art at the beginning of January 1991.

(*Id.* ¶ 167 (emphasis added).)[5] Thus, according to Mr. Weiss, the specification only describes an "inherent" "need" for accomplishing information transfers "necessary" to a conditional access method of distribution. Obviously, a "need" is not the equivalent of "descriptive means [such] as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention." *Lockwood*, 107 F.3d at 1572. Such disclosure would do nothing more than provide a place holder for future development. *See Automotive Techs.*, 501 F.3d at 1284 ("[T]he specification provides

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[5] Mr. Weiss's declaration also finds disclosure where there is none. In the words of the specification each of Figures 1d, 1e, and 1f only describes a "high level block diagram." '992 patent, 4:14-36. The diagrams simply show boxes representing transmission and reception systems connected by lines. They and the associated text in the specification say nothing about conditional access, designating receiving devices, or anything else about user selectability.

'only a starting point, a direction for further research' on using electronic sensors for sensing side impact crashes; it does not provide guidance to a person of ordinary skill in the art on how to make or use an electronic side impact sensor.") (citation omitted).

Mr. Weiss's declaration presents the kind of opinion that the Federal Circuit has specifically held does not satisfy the enablement requirement: litigation-driven expert opinion that substitutes for the "novel" aspects of the claimed invention. *Automotive Techs.*, 501 F.3d at 1283. Here, Mr. Weiss's opinion could not be clearer — the specification does not disclose "conditional access." According to Mr. Weiss, the "selectable" function of the receiving stations presented an "inherent need" that would signal to a skilled artisan what was required.
Mr. Weiss's opinion and Acacia's opposition ignore the fact that the Yurt applicants relied on the so-called novelty of the receiving stations' selectability *as the only basis for distinguishing the Hoarty reference*. Indeed, Mr. Weiss's opinion contradicts the applicants' statements that the "receiving stations" selectability was supposedly novel. Acacia cannot substitute Mr. Weiss's opinions in place of what the applicants failed to include in the specification.[6]

For all these reasons, Claim 11 lacks written description. And because the specification does not enable even the basic features of the receiving stations — "novel" features on which the applicants relied to gain allowance, Claim 11 also fails the enablement requirement.

VII. CONCLUSION

For all the above reasons, Claims 41 and 45 of the '992 patent, 17-19 of the '863 patent, and 11 of the '720 patent fail the written description and enablement requirements.

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[6] Neither Acacia nor Mr. Weiss explains how "conditional access" systems would work across the diverse technologies, such as broadcast TV, ISDN, microwave, cable, or satellite delivery systems, described by the patent. *See, e.g.*, '992 patent, 15:66-67, 16:4-15. Whether the patent's "subscriber selectable receiving stations" are (or include) modems, satellite receiving dishes, cable set-top boxes, broadcast antennas, or related devices, the specification and Mr. Weiss do not say. *See In re Ghiron*, 442 F.2d 985, 991 (C.C.P.A. 1971) ("If . . . practice [of a method claim] requires [a] particular apparatus, . . . it is axiomatic that the application must . . . provide a sufficient disclosure of that apparatus if such is not already available.").

Respectfully submitted,

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MORRISON & FOERSTER LLP

By: */s/ Rachel Krevans*
Rachel Krevans

Rachel Krevans
Matthew I. Kreeger
Jason A. Crotty
David M. Hymas

Attorneys for Defendants
ECHOSTAR SATELLITE LLC and
ECHOSTAR TECHNOLOGIES CORP.

Dated: April 3, 2009

JONES DAY

By: */s/ Kevin G. McBride*
Kevin G. McBride

Victor G. Savikas
Louis Touton
Kevin G. McBride

Attorneys for Defendant
THE DIRECTV GROUP, INC.

ECF CERTIFICATION

Pursuant to General Order No. 45, § X.B., the filing attorney attests that she has obtained concurrence regarding the filing of this document from the other signatory to the document.